

### Remarks

Claim 11 has been amended to be an independent claim that includes all of the limitations previously found in claim 1. Claim 13 has been canceled. Claims 1-11 and 20-49 remain pending in the application.

### Information Disclosure Statement

On page 16, paragraph (B) of the office action, the Examiner stated that she had seen evidence of an IDS being filed. The Applicant respectfully requests that the Examiner review the electronic content of PALM/PAIR for the present patent application. At least on the date that this response is being filed, the PALM/PAIR system contains a copy of the IDS as filed on June 13, 2005 along with several non-patent literature references also filed on the same day. A review and acknowledgement of the associated SB08A/B sheets by the Examiner is requested.

### Amendments to Specification

The specification was objected under 35 U.S.C. 132 for introducing new matter into the disclosure. Specifically, the Examiner objected to the addition of the phrase "based upon the plan requirements data" to claims 1 and 30. Support for this phrase can be found in paragraphs [0036], [0037], and [0070] of the specification. Reconsideration and withdrawal of the new matter objection under 35 U.S.C. 132 is respectfully requested.

### Claim Objections

Claims 11 and 13 were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. In particular, the Examiner stated that claims 11 and 13 do not pass the "Infringement Test" for dependent claims. The Applicant disagrees with the Examiner's assertion that these claims are in improper dependent form; however, to simplify the continued examination of the present application, claim 11 has been converted into an independent claim and claim 13 has been canceled. It should be noted that claim 11 now closely follows the claim format acknowledged as a permitted claim format. See, for example, the decision in the case of In re Beauregard, 35 USPQ2d 1383 (1995). The Applicant respectfully requests that the objection to amended claim 11 under 37 CFR 1.75(c) be withdrawn.

35 U.S.C. §112

Claims 1-11, 13, and 20-49 were rejected under 35 U.S.C. 112, first paragraph as containing new matter. In particular, as noted previously, the Examiner has asserted that the addition of the phrase "based upon the plan requirements data" to claims 1 and 30 constitute new matter being added to the present patent application. Dependent claims 2-11, 13, 20-29, and 31-49 through their dependency on either independent claim 1 or 10 were rejected for incorporating the same phrase. As noted above, support for this phrase can be found in paragraphs [0036], [0037], and [0070] of the specification. Based on the support found in the specification, reconsideration and withdrawal of the new matter rejection of claims 1-11 and 20-49 under 35 U.S.C. 112, first paragraph is respectfully requested.

35 U.S.C. §103

Claims 1-5, 11, 13, 20-27, 30-32, and 37-38 were rejected under 35 USC 103(a) as being unpatentable over Lockwood 4,567,359 (Lockwood '359) in view of Warady 6,067,522 (Warady '522). The Applicant agrees with the Examiner's statement that Lockwood '359 fails to disclose one of the presently claimed features found in independent claims 1, 11, and 30. The feature not taught by Lockwood '359 is the presentation of a description of insurance plan options that includes an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data. The Examiner asserts that Warady '522 teaches this claimed feature. Warady '522 generally discloses a computerized database management system for employee benefit enrollment. This system enrolls a person in a health plan from a benefit provider and generates a bill for fees due to that benefit provider as a result of the enrollment. Within Warady '522 at column 5, line 65 through column 6, line 11 a prerequisites table is described. The prerequisites table contains information on prerequisites that must be met before an employee can be enrolled in the plans. Applicant respectfully suggests that Lockwood '359 and Warady '522 when considered individually or together in combination, fail to suggest or teach all of the elements of the presently pending independent claims 1, 11, and 30. While Warady '522 may disclose a prerequisites table being stored in a database, Warady '522 does not disclose presenting on a display device insurance plan options that include a plan may be offered but is not

currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data. Thus, neither Lockwood '359 nor Warady '522 teach the present invention as claimed in independent claims 1, 11 and 30.

Claims 2-5 and 20-27 depend from claim 1 and therefore are allowable over Lockwood '359 and Warady '522 for the same reasons that claim 1 is allowable. Claims 31, 32, 37 and 38 depend from claim 30 and therefore are allowable over Lockwood '359 and Warady '522 for the same reasons that claim 30 is allowable. Therefore, under 35 USC 103(a), Lockwood '359 and Warady '522 fail to teach the present invention as claimed in claims 1-5, 11, 20-27, 30-32, and 37-38 and withdrawal of this rejection is respectfully requested.

Claims 6-10, 28-29, 39-42, and 46 were rejected under 35 USC 103(a) as being unpatentable over Lockwood '359 and Warady '522 as applied to claim 1 and further in view of Gamble 6,163,770 (Gamble '770). Similar to the remarks regarding the Lockwood '359 and Warady '522 references, Gamble '770 fails to teach presenting on a display device insurance plan options that include a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data as presently claimed in independent claims 1, 11, and 30. Thus, Lockwood '359, Warady '522, and Gamble '770 when considered individually or together in combination, fail to suggest or teach all of the elements of the presently pending independent claims 1, 11 and 30. Claims 6-10 and 28-29 depend from claim 1 and therefore are allowable over Lockwood '359, Warady '522, and Gamble '770 for the same reasons that claim 1 is allowable. Claims 39-42 and 46 depend from claim 30 and therefore are allowable over Lockwood '359, Warady '522, and Gamble '770 for the same reasons that claim 30 is allowable. Therefore, under 35 USC 103(a), Lockwood '359, Warady '522, and Gamble '770 fail to teach the present invention as claimed in claims 6-10, 28-29, 39-42, and 46 and withdrawal of this rejection is respectfully requested.

Conclusion

On the basis of the foregoing, Applicant respectfully submits that claims 1-11 and 20-49 are now believed to be in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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